

YAMAMOTO, N. et al.  
Serial No. 10/087,994

Atty Dkt: 900-420  
Art Unit: 1746

### REMARKS/ARGUMENTS

Reexamination of the captioned application is respectfully requested.

#### **A. SUMMARY OF THIS AMENDMENT**

By the current amendment, Applicants basically:

1. Editorially amend the specification.
2. Thank the Examiner for the indication of allowable subject matter in dependent claims 4 and 5<sup>1</sup>.
3. Amend claims 1, 3, 4 and 6.
4. Add new claims 8 - 34, including new independent claims 8, 9, 11, 12, 14, 15, 16, 21, 23 and 27 - 34.
5. Respectfully traverse all prior art rejections.

#### **B. SPECIFICATION AMENDMENTS**

The amendments to the specification are deemed self-explanatory. The amendment on page 3 regarding the temperature is supported by the priority document, which is incorporated by referenced as stated on the first page of the specification. The undersigned believes that the Examiner will be able to discern the "100°C " even from the Japanese language priority document. If such is not the case, please advise.

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<sup>1</sup> Claims 4 and 5 were objected to as being dependent upon a rejected base claim, but indicated as being allowable if rewritten in independent form including all limitations of the base claim and any intervening claims (see enumerated paragraph 3 of the Office Action).

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### C. CLAIM AMENDMENTS

Punctuation has been amended in dependent claims 4 and 6. Independent claims 1 and 3 have been amended to refer to "the material for fuel to generate hydrogen", rather than "the material for fuel to generate fuel". For support, see (for example) page 14, lines 11 – 13 of the specification.

### C. NEW CLAIMS

The following new claims have been added:

- New claims 8 and 9 are based on claim 1 plus limitations of claims 4 and 5, respectively.
- New claim 10 is multiply dependent upon claim 8 or 9.
- New claims 11 and 12 are based on claim 3 plus limitations of claims 4 and 5, respectively.
- New claim 13 is multiply dependent upon claim 11 or 12.
- New claims 14 and 15 are based on claim 3 plus limitations of claims 6 and 7, respectively.
- New independent claim 16 resembles original claim 3, but describes the filter as being external to the housing.
- New dependent claims 17 – 20, correspond to original claims 4 – 7 but depend upon independent claim 16.
- In new claims 21 and 23 differ from respectively claims 1 and 3 by changing "to generate fuel" (in the phrase "the material for fuel to generate fuel") to "the material for fuel comprising one or more materials selected from methanol, formaldehyde, and formic acid.
- Claim 22 depends from claim 21, and claims 24 – 26 multiply depend from claims 21 or 23.

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- Claims 27 - 30 are based on respective claims 8, 9, 11, or 12, plus limitations from claim 6.
- Claims 31 - 34 are based on respective claims 8, 9, 11, or 12, plus limitations from claim 7.

#### D. PATENTABILITY OF THE CLAIMS

Claims 1-3, 6 and 7 stand rejected under 35 USC 103(a) as being unpatentable over US Patent 6,531,239 to Heller. All prior art rejections are respectfully traversed for at least the following reasons.

In view of the reasons for allowance articulated at the top of page 4, the claims which include limitations from original dependent claims 4 and 5 are deemed allowable. Among these are independent claims 8, 9, 11, 12, 27 - 30, 31 - 34, and claims 10, 13 which ultimately depend on one or more of these claims.

While broader than claims 4 and 5, independent claims 1 and 3 have been amended specifically to refer to generation of hydrogen and therefore are deemed allowable for the same reasons as claims 4 and 5. Similarly, new independent claims 14 and 15 which are comparably directed to hydrogen, and dependent claim 13, are deemed allowable.

New claims 21 and 23 differ from respectively claims 1 and 3 by changing "to generate fuel" (in the phrase "the material for fuel to generate fuel") to "the material for fuel comprising one or more materials selected from methanol, formaldehyde, and formic acid". Among other limitations, the inserted amendatory limitation is not taught or suggested by US Patent 6,531,239 to Heller, for which reason claims 21 and 23 and claims 22 - 26 are deemed allowable.

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Independent claim 16 has been amended to describe the filter as being external to the housing. The Office Action correctly admits that US Patent 6,531,239 to Heller does not explicitly describe a housing. Neither does Heller teach or suggest that a biochemical catalyst be disposed in a filter. As such, Heller cannot teach or suggest any relationship between a housing and a filter, much less a relationship in which the filter is external to the housing. Such is particularly apparent in view of the fact that the Heller device is intended for implantation into a person or animal (e.g., to operate an electrical device). See, e.g., the paragraph bridging columns 2 and 3 of US Patent 6,531,239 to Heller. Such implantation profoundly militates against any suggestion of a filter situation external to a housing. Accordingly, independent claim 16 and claims 17 – 20 dependent thereon are deemed allowable.

#### E. MISCELLANEOUS

In view of the foregoing and other considerations, all claims are deemed in condition for allowance. A formal indication of allowability is earnestly solicited.

The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.


Should the Examiner feel that an interview with the undersigned would facilitate allowance of this application, the Examiner is encouraged to contact the undersigned.

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Respectfully submitted,

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